

REMARKS

Applicant respectfully requests reconsideration and allowance of the subject application. Claims 1-10, 52, 53, 56-67 and 71-81 are pending in this application.

The claims are subjected to a restriction requirement under 35 U.S.C. §121 as allegedly containing three distinct inventions:

- I. Claims 1-10 and 52-58
- II. Claims 59-67, 71 and 78-81
- III. Claims 72-77

Applicant hereby elects, **with traverse**, to prosecute claims 59-67, 71 and 78-81 (Group II) in the event that the restriction requirement is maintained. The election is made with traverse because the restriction requirement is improper and should be withdrawn. The reasons that the restriction requirement is improper are enumerated below. Any one of the reasons is sufficient to demonstrate that the requirement should be withdrawn. The combination of the reasons overwhelmingly supports withdrawal of the requirement as the only appropriate course.

Reason 1: Untimely

The Patent Rules state that a requirement for restriction “will be made before any action on the merits; however, it may be made at any time before final action in the case at the discretion of the examiner.” 37 C.F.R. §1.142(a).

In the current case, the restriction requirement was not made before any action on the merits, nor was it in the first Action on the merits or the second Action on the merits. Instead, the restriction requirement was not made until the first Action in response to a request for continued examination, *after the Final Action* in the case.

With respect to the Group I and Group II claims, the Office could have brought the restriction requirement in an earlier Action prior to the filing of the request for continued examination. The requirement could have been more easily considered at an earlier time in prosecution. Applicant has now expended considerable resources responding to arguments made on the merits of all pending claims, only to have this effort thwarted by a late arriving restriction requirement.

The fact that some of the claims have been amended does not lessen the Office's obligation to bring the requirement in a timely fashion, particularly since the claims have not changed in substance in regards to the stated "distinctions".

Reason 2: Without Carrying Its "Serious Burden", Office Must Examine Entire Application

MPEP 803 states:

If the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, *even though it includes claims to distinct or independent inventions*. (Emphasis added).

Applicant contends that all three groups can be conveniently searched and examined together without burden to the Office. As supporting evidence, the Office has already issued several Actions on the merits in the parent case. Accordingly, the Office must examine the entire application on the merits, even though it might include claims to distinct or independent inventions.

Reason 3: Unduly Burdensome on Applicant

Imposing a restriction requirement at this late stage in prosecution is unduly burdensome to Applicant. Applicant is forced to present a Response here, and if the requirement is upheld, file and prosecute three separate applications on the merits. This results in a substantial financial burden on the Applicant for an invention that can be handled effectively in one application, and in fact, has been handled in one application through an entire examination cycle.

It is further noted that these extra costs are added to the expenses already levied on Applicant for filing an RCE.

Reason 4: Increase Burden on Office

Searching and examining three applications, where one application has sufficed for several Actions, dramatically increases the burden on the Office. The Office must make three duplicative searches, rather than one. Withdrawing the restriction requirement and keeping the claims together in one application would prove more efficient and effective for the Office in handling the subject invention.


Conclusion

Applicant respectfully requests withdrawal of the restriction requirement,
and issuance of the subject application.

Respectfully Submitted,

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By:


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